

REMARKS

In response to the final Official Action of September 26, 2007, applicant respectfully request reconsideration of the rejection of the claims. Claims 1-26 are currently pending, and all claims have been rejected based on art.

Claim Rejections Under 35 USC §103

At section 3 of the final Official Action, claims 1-6, 8-16, 23 and 24 are rejected under 35 USC §103(a) as unpatentable in view of US Patent No. 6,825,830 to Kanesaka et al. (hereinafter Kanesaka) in view of US Patent Application Publication No. 2002/0095538 to Marshall, and further in view of US Patent Application Publication No. 2002/0178631 to Morton. In applicant's previous response filed on 23 July 2007, claim 1 was amended to recite that with respect to the claimed amulet that said amulet further comprises a hanging arrangement for allowing the amulet to be worn on the torso of a human user so that the display is directed away from said human user to allow said human user to self-express himself/herself via said display on said amulet.

In response thereto, the Office asserts that Kanesaka teaches a keypad, display, two mechanically separate structural parts, the first part being a keypad and the second part being an amulet that comprises the display, a short-distance communication link between the keypad and the amulet and that the amulet further comprises a hanging arrangement for allowing the amulet to be worn on the torso of a human user. The Office goes on to state that Kanesaka fails to teach that the amulet comprises a microphone and speaker for setting up an audio interface between the personal communication device and a human user, but cites Marshall for showing such features.

The Office also states that Kanesaka and Marshall in combination fail to teach that the display is directed away from the human user to allow the human user to self-express himself/herself via the display of the amulet, but cites Morton for showing such features, relying on Figure 3 and display 28 which can be viewed by the doctor as set forth in paragraph [0029] of Morton. Applicant respectfully disagrees.

Preliminarily applicant reiterates the arguments presented in the amendment filed on 23 July 2007 with respect to the rejection of claim 1. As pointed out at pages 8-10 of said response, even if Kanesaka and Marshall are combined in the manner suggested by the Office (which combination is repeated in the present final Official Action), it fails to teach the claimed invention since there is no suggestion in Marshall of using display 210 shown in Figure 8 for other than visual identification of operation of module 200, and no suggestion that it is to be worn on the torso of the user so that the display is directed away from said human user to allow said human user to self-express himself/herself via said display of said amulet. This of course is apparent because of the nature of the invention disclosed in Marshall, namely a portable entertainment media storage module, rather than a personal telecommunication device as disclosed and claimed in the present application. Thus a review of the previously cited art as well as newly cited Morton is believed to be instructive for purposes of showing that the suggested combination of these references would not be apparent to one of ordinary skill in the art to which the present invention pertains (i.e., a telecommunication device for personal use), and furthermore that even if combined the combination fails to suggest claim 1.

More particularly, Kanesaka is directed to an information processing system and is shown to be in the field of personal communication devices, the main purpose of which is to offer a means for long-distance wireless communications such as shown in Figure 1 thereof illustrating a configuration of an information processing system that has a first information processing device (portable telephone) 100, a second information processing device (a wristwatch-type information processing device) 101, and a relay station (base station) 102 communicating with the first information processing device (portable telephone) 100 (Kanesaka, col. 4, lines 18-26). Kanesaka is classified in US Class 345/156; 345/158; 455/555; and 455/556.1, as well as in International Class G09G 5/00.

Marshall is directed to a portable information storage module and thus comes from the field of personal electronic entertainment devices. The main purpose of the device is to offer a means for the user to personally entertain himself/herself with content that comes from a miniature electronic memory in the device. It is intended that the user can easily carry the device. Marshall is classified in US Class 710/74 and in International Class G06F 13/12. As is evident from a review of the above classifications, the only thing that the classification of Marshall has in common with the classification of Kanesaka is at the topmost main International Class "G," i.e., "Physics."

Newly cited Morton is directed to a medical information storage and display device and comes from the field of electronic identification cards. The main purpose of Morton is to identify the person that carries the device as well as their medical information so as to be viewable by other people in proximity to said person, such as a doctor. Morton is classified in US Class 40/655 and in International Class G09F 3/14. Thus the only portion of the classification of Morton that is in common with Kanesaka is International Class "G09" which is directed to "Educating, Cryptography, Display, Advertising, Seals." With Marshall the classification of Morton shares only the very topmost main International Class "G," i.e., "Physics."

It is therefore apparent in view of the different classifications of these three references that it would be virtually impossible to consider that these three publications are from the same or even similar technical fields. Thus in the present situation a serious question exists as to whether the three references cited by the Office in the rejection of claim 1 are in fact all relevant prior art.

As recently set forth by the US Patent and Trademark Office in the document entitled "Examination Guidelines for Determining Obviousness Under 35 USC 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (*Fed. Register*, vol. 52, no. 195 (October 10, 2007))"

“The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed” (footnote omitted) (Fed. Register p. 57527).

Furthermore, said Guidelines make specific reference to MPEP §§901-901.06(d) and §§2121-2129. Applicant notes that MPEP §901.01(c) relating to analogous arts provides that the art to be searched is the invention as claimed as classified but also that analogous arts must be searched regardless of where the claimed invention is classified. Various examples of analogous arts are given such as when searching for a tea mixer it would be permissible to search in the concrete mixer art since they are both in the “mixing” art.

In the present rejection, the art of the three cited references are quite different from each other as noted above. In particular, Kanesaka is essentially an advanced mobile telephone while Marshall is essentially a present-day personal audio player, while Morton is directed to an electronic identification tag, particularly for patient/doctor situations. It is respectfully submitted that it would require an enormous amount of hindsight reconstruction to determine that there is anything in common between these three completely different technical references.

In particular, applicant points out that based upon the lack of prior art directed to the present invention as a whole, the concept disclosed and claimed was not found in the art; namely, the concept of combining wireless personal communications with self-expression to be seen in the immediate surroundings of the user of the device. It is only after the present invention has been disclosed that the Office cobbles together three different patent publications in three different technical fields to show that somehow it would be obvious to combine these references in the particular manner set forth in the final Official Action. However, in view of the recent *KSR*¹ decision as well as the above-recited Guidelines, the Office has failed to show why the combination of these references would be allowed in view of 35 USC §103 as discussed in the *KSR* decision. Notably, there is a failure to show why any of the rationales required in view

of the *KSR* decision are in fact found for the rejection of claim 1 of the present application. As set forth in the above Guidelines,

“The key to supporting any rejection under 35 USC 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” (Fed. Register p. 57528)

These rationales are articulated in the Guidelines at page 57529.

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element or another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) ‘Obvious to try’ – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.”

In fact, the Office has failed to meet any of these rationales since: There is no showing that combining the prior art elements according to known methods would yield predictable results; there is no showing that simple substitution of one element for another would obtain predictable results; there is no showing that there can be use of known techniques to improve similar devices in the same way; there is no showing that applying a known technique to a known device ready for improvement to yield

¹ *KSR International v. Teleflex Inc.*, 550 US ___, 82 USPQ 2d 1385 (2007).

predictable results; there is no showing of an “obvious to try” rationale of choosing from a finite number of identified, predictable solutions with a reasonable expectation of success; there has been no showing that known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; nor has there been a showing of some teaching, suggestion or motivation in the prior art that would lead one of ordinary skill to modify the prior art reference or combine the prior art reference teachings to arrive at the claimed invention. In fact the Office merely states that Marshall teaches such “features” (the fact that Kanesaka fails to teach the amulet comprises a microphone and speaker for setting up an audio interface between the personal telecommunication device and a human user) and that Morton teaches such additional features (a display being directed away from a human user to allow the human user to self-express himself/herself via the display of the amulet).

As such, it is respectfully submitted that the Office has failed to adhere to the examination guidelines as noted above with respect to both the selection of the prior art and the analysis of such prior art to show a rationale for obviousness.

Furthermore, even if Kanesaka and Marshall and Morton are combinable, they fail to disclose the present invention as claimed. In particular, the Office relies on Morton with respect to the display 28 shown in Figure 3. Cited paragraph [0029] merely states that the medical information storage and display device is programmed to include any relevant information that would aid doctors and other medical personnel in effectively treating a person that has been incapacitated. As noted in paragraph [0029], the doctor would simply press the programming button 30 of the device as shown in Figure 3 to view the programmed information on the display 28. After assessing this information the doctor can properly provide medical treatment to the patient without endangering the patient because of the knowledge of their medical history as presented to the doctor via the display. However, it is therefore abundantly clear that display 28

shown in Morton is to be worn by a patient typically for long periods of time and especially to provide medical information when the patient is incapacitated. In other words, the information is not displayed on the display until the programming buttons 30 are depressed by the doctor or other medical personnel. Of course the rationale for this is easy to understand since the electronic ID tag disclosed in Morton would be constantly around the neck of the patient for long periods of time and it is only to be used in an emergency or other time when a doctor or other medical personnel needs to learn about the medical history of that person, especially when they are incapacitated and therefore unable to provide that information to the doctor or other medical personnel. If the information was permanently displayed, there would be an enormous waste of battery power associated with the device as well as potential of disclosure of private personal medical data to unauthorized people in the vicinity of the wearer of the device. In short, the medical information that can be displayed on device 28 is not constantly displayed on the display and is therefore not available for self-expression by the user of the medical ID device. In fact, the idea of personal expression of medical information by use of such a medical ID device is preposterous.

It is therefore respectfully submitted that Morton fails to disclose the claimed feature for which it is relied upon by the Office; namely, "to allow said human user to self-express himself/herself via said display of said amulet." Furthermore, this feature of the present invention as claimed is missing and not suggested in Kanesaka and Marshall. It is therefore respectfully submitted that claim 1 as currently presented is not obvious in view of the cited art, regardless of any hypothetical rationale for combining these references in the manner as suggested by the Office.

Independent personal telecommunication device claim 23 is also not unpatentable under 35 USC §103(a) in view of Kanesaka, Marshall and Morton since it recites features similar to those set forth in claim 1.

Furthermore, dependent claims 2-6, 8-16 and 24 are further distinguished over the cited art due to their ultimate dependency from either independent claim 1 or 23, which are both believed to be distinguished over the cited art.

Referring to section 4 of the Official Action, claims 17, 18, 22, 25 and 26 are rejected under 35 USC §103(a) in view of Marshall, Kanesaka and Morton. With respect to independent claim 17, this claim recites a hanging arrangement for allowing the amulet part to be worn on the torso of the user so that the display is directed away from said human user to allow said human user to self-express himself/herself via the display on said amulet. Morton is again cited for this feature. As discussed above with regard to claim 1, the combination of these references in the manner as suggested is respectfully contested by the applicant, and even if combined in the manner as suggested, fails to disclose the combination of elements including the feature of the hanging arrangement for allowing the amulet part to be worn on the torso of the user so that the display is directed away from said human user to allow said human user to self-express himself/herself via said display of said amulet. It is therefore respectfully submitted that claim 17 is distinguished over the cited art.

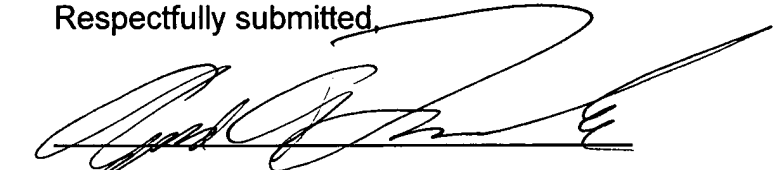
Dependent claims 18, 22 and 26 recite additional features and are therefore believed to be further distinguished over the cited references due to their ultimate dependency from independent claims which are also believed to be distinguished over the cited art.

At section 5, claim 7 is rejected under 35 USC §103(a) in view of Kanesaka, Marshall, Morton and US Patent Application Publication No. 2004/0240163 to Adams. Claim 7 depends from claim 1 and is believed to be allowable over the cited art due to its dependency from a claim which is believed to be allowable.

At section 6, claims 19-21 are rejected under 35 USC §103(a) in view of Marshall, Kanesaka, Morton and US Patent No. 5,956,630 to Mackey. These claims are also believed to be distinguished over the cited art due to their ultimate dependency from an independent claim which is believed to be allowable.

In view of the foregoing, it is respectfully requested that reconsideration of the rejection of the claims be made and that the present application proceed to allowance.

Respectfully submitted,



Alfred A. Fressola
Attorney for Applicant
Registration No. 27,550

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WARE, FRESSOLA, VAN DER SLUYS
& ADOLPHSON LLP
Bradford Green, Building Five
755 Main Street, P.O. Box 224
Monroe, CT 06468
Telephone: (203) 261-1234
Facsimile: (203) 261-5676
USPTO Customer No. 004955